

### **REMARKS**

Applicants respectfully request reconsideration of this Patent Application, particularly in view of the above Amendment and the following remarks. No additional fee is required for this Amendment as the number of independent claims has not changed, and the total number of claims has not changed.

### **Amendment to the Claims**

Applicants amended Claims 1, 13, and 20 to recite the coating liquor or material includes 5% to 95% by weight of the masking agent. Support for this Amendment can be found at, for example, page 2, second full paragraph, of Applicants' Specification. No new matter has been added to the claims by this Amendment.

### **Claim Rejections - 35 U.S.C. §103**

#### **Hiltzik et al.**

The rejection of Claims 1-4, 6, 8-11, 13, 17, 18, 20, and 21 under 35 U.S.C. §103(a) as being unpatentable over Hiltzik et al., U.S. Patent Application Publication 2003/0082382, is respectfully traversed.

Applicants amended independent Claims 1, 13, and 20 to recite the coating liquor or material includes 5% to 95% by weight of the masking agent. The Hiltzik et al. Publication does not disclose or suggest incorporating 5% to 95% by weight masking agent. The Hiltzik et al. Publication discloses adding pigments to the coating in amounts of only 2% or less (*See* Table VIII). As discussed in Paragraph 0067, the Hiltzik et al. Publication discloses that the pigments and amounts in Table VIII are to be used to attain the desired color and benefits of the coating.

As the Hiltzik et al. Publication specifically discloses forming a thin continuous film on the activated carbon, one skilled in the art would not find any suggestion or motivation to include higher amounts of pigment materials such as mica/titanium dioxide, which in higher amounts would be expected to result in a discontinuous film. The Hiltzik et al. Publication discloses a continuous film to provide the desired purpose of reducing dust. A discontinuous film would not provide the desired reduced dusting. As discussed on page 3, lines 19-21, of Applicants' Specification, particles in the coating liquor can result in a discontinuous film, thereby leaving open pores to the surface of the activated carbon. The Hiltzik et al. Publication only discloses using pigments in amounts of 2% or less, it does not disclose or suggest using 5% or more, as in Applicants' claimed invention. The Hiltzik et al. Publication actually teaches away from Applicants' recited higher

amounts of masking agent, so as to not produce a discontinuous film. As the Hiltzik et al. Publication teaches away from using higher amounts of pigment particles, Applicants' claimed invention would not have been obvious to one skilled in the art.

Furthermore, the Hiltzik et al. Publication does not disclose or suggest an activated carbon coating material that includes a silicone compound having an add-on level of at least about 5%, as in Applicants' claimed invention. The Examiner alleges the Hiltzik et al. Publication discloses in Paragraph 60 a "coating of greater than about 3.5%" if a larger canister is used. However, the Examiner should read Paragraph 60 more closely, and in context with Paragraph 59. When read in proper context, Paragraphs 59 and 60 say that with coatings of polyethylene greater than 3.5%, ORVR capacity dropped and a larger canister will be required. Paragraph 60 continues on to say that other coating materials, such as the siloxane material in Table V, would:

have to be used at less than a coating of 3% due to their great packing disruption and certain loss of BWC, GWC and ORVR capacity. (emphasis added).

Paragraph 60 continues to say that an amount lower than 3% of the other disclosed coating materials "may not" cause a reduction in the ORVR capacity.

The Examiner needs to properly consider the teachings of the Hiltzik et al. Publication as a whole, instead of improperly taking a statement out of context.

The Hiltzik et al. Publication as a whole clearly discloses and suggests coating material amounts of less than 3% for coating materials other than polyethylene. Also, one skilled in the art would not understand the teachings of the Hiltzik et al. Publication to be: keep increasing the size of the canister until the ORVR capacity is the same as for the uncoated materials. Such an interpretation is not reasonable. The Hiltzik et al. Publication discloses and suggests to one skilled in the art that the coating materials including a silicone material are effective only in amounts of less than 3%. There is simply no suggestion or motivation, and no reasonable expectation of success, provided by the Hiltzik et al. Publication to apply a silicone material-based coating to activated carbon in an amount greater than 3%.

Therefore, Applicants' claimed invention, which recites an activated carbon coating material that includes a silicone compound having an add-on level of at least about 5%, would not have been obvious to one skilled in the art in view of the Hiltzik et al. Publication.

Claims 2-4, 6, 8-11, 17, 18, and 21 depend from one of Claims 1, 13, and 20, and are thus patentable for at least the same reasons as Claims 1, 13, and 20.

Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) as being unpatentable over the Hiltzik et al. Publication.

**Hiltzik et al. in view of Karapasha**

The rejection of Claims 1-4, 6, 8-11, 13, 17, 18, 20, and 21 under 35 U.S.C. §103(a) as being unpatentable over Hiltzik et al., U.S. Patent Application Publication 2003/0082382, in view of Karapasha, WO 91/12030, is respectfully traversed.

The Karapasha Publication is cited for teaching particular types of mineral particles. The above comments regarding the Hiltzik et al. Publication are also applicable here and are incorporated by reference. The Karapasha Publication does not rectify the deficiencies of the Hiltzik et al. Publication discussed above.

Regarding the above Amendment, the Hiltzik et al. Publication does not disclose or suggest incorporating 5% to 95% by weight masking agent. The combination of the Hiltzik et al. Publication and the Karapasha Publication does not make up for the deficiency of the Hiltzik et al. Publication. Contrary to the Examiner's position, the Karapasha Publication does not disclose "any polymer binder" (Office Action, page 3), but discloses particular binder materials known in the art, those that include starch, cellulose, gum acacia/gum arabic, and soluble gelatin materials. The Karapasha Publication does not disclose or suggest that elastomeric or silicone materials, as in Applicants' claimed invention, can be used as binder materials.

Applicants' claimed invention would not have been obvious to one skilled in the art in view of the combination of the Hiltzik et al. Publication and the Karapasha Publication. As discussed above, the Hiltzik et al. Publication teaches away from using higher amounts of pigment particles in order to provide a thin, continuous polymer film to limit dust penetration. Applying particular masking agents of the Karapasha Publication to the film of the Hiltzik et al. Publication still does not provide Applicants' claimed invention, as the Hiltzik et al. Publication teaches away from providing the masking agents in Applicants' recited amounts.

For at least the above reasons, Applicants request reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) as being unpatentable over the Hiltzik et al. Publication in view of the Karapasha Publication.

**Karapasha in view of Hiltzik et al.**

The rejection of Claims 1-4, 6-11, 13, 17, 18, 20, and 21 under 35 U.S.C. §103(a) as being unpatentable over Karapasha, WO 91/12030, in view of Hiltzik et al., U.S. Patent Application Publication 2003/0082382, is respectfully traversed.

The Examiner alleges it would have been obvious to one skilled in the art to use the silicone emulsion or elastomers of the Hiltzik et al. Publication in the

invention of the Karapasha Publication because the Examiner says the Karapasha Publication discloses “any known polymer without limitation can be used as a binder” (Office Action page 6). As discussed above, the Karapasha Publication does not disclose “any known polymer without limitation,” but discloses particular types of binder materials that were/are known in the art and that would not continuously coat the carbon. The binders of the Karapasha Publication are starch, cellulose, gum acacia/gum arabic, and soluble gelatin materials.

The Karapasha Publication discloses bonding white particles to carbon particles to form a composition of bonded particles (*See* Page 4, lines 18-27). The bonded particles are lighter in color than the original black carbon, because of the color of the white particles. However, the Karapasha Publication teaches away from a continuous coating, as disclosed in the Hiltzik et al. Publication. The Karapasha Publication says the binder “will comprise only a small percentage (1-10%, with 5-6% being typical) of the final particles” because in a greater amount the binder interferes with the odor-controlling properties of both types of particles (Page 15, lines 7-14).

As the Karapasha Publication teaches a minimal amount of binder to not impede the odor-adsorbing properties of the carbon, the Karapasha Publication teaches away from the continuous polymer film of the Hiltzik et al. Publication. Therefore, it would not have been obvious to one skilled in the art to apply the film-

forming polymers of the Hiltzik et al. Publication to the teachings of the Karapasha Publication.

For at least the above reasons, Applicants request reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) as being unpatentable over the Karapasha Publication in view of the Hiltzik et al. Publication.

**Claim 7**

The rejection of Claim 7 under 35 U.S.C. §103(a) as being unpatentable over Hiltzik et al., U.S. Patent Application Publication 2003/0082382, or Karapasha, WO 91/12030, in view of Hiltzik et al., and further in view of Cavezzan et al., U.S. Patent 4,954,539, is respectfully traversed. Claim 7 depends from Claim 1, and is thus patentable for at least the same reasons as discussed above for Claim 1.

**Claim 22**

The rejection of Claim 22 under 35 U.S.C. §103(a) as being unpatentable over Hiltzik et al., U.S. Patent Application Publication 2003/0082382, Hiltzik et al. in view of Karapasha, WO 91/12030, or Karapasha in view of Hiltzik et al., further in view of Hogenson, U.S. Patent 4,643,783, is respectfully traversed.



Claim 22 depends from Claim 13, and is thus patentable for at least the same reasons as discussed above for Claim 13.

### **Conclusion**

Applicants intend to be fully responsive to the outstanding Office Action. If the Examiner detects any issue which the Examiner believes Applicants have not resolved in this response, Applicants' undersigned attorney requests a telephone interview with the Examiner.

Applicants sincerely believe that this Patent Application is now in condition for allowance and, thus, respectfully request early allowance.

Respectfully submitted,



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